

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

CIRBA INC. (d/b/a DENSIFY) as the
successor-in-interest to CIRBA IP INC.,

Plaintiff,

v.

VMWARE, INC.,

Defendant.

C.A. No. 19-742-GBW

**VMWARE’S NOTICE OF FINAL OFFICE ACTION
REGARDING *EX PARTE* REEXAMINATION OF U.S. PATENT NO. 8,209,687**

VMware, Inc. submits this notice to advise the Court of related proceedings regarding U.S. Patent No. 8,209,687 (the “’687 patent”), which Cirba Inc. (d/b/a Densify, the successor-in-interest to Cirba IP Inc.) has asserted against it.

On February 24, 2021, the U.S. Patent and Trademark Office (“PTO”) granted VMware’s request for *ex parte* reexamination of asserted claims 3 and 7 of the ’687 patent. (D.I. 969.)

On October 6, 2021, the PTO issued a Non-Final Office Action rejecting both asserted claims of the ’687 patent as obvious. (D.I. 1048.)

On July 7, 2022, the PTO issued another Non-Final Office Action again rejecting both asserted claims of the ’687 patent as obvious. (D.I. 1317.)

On May 1, 2023, a jury found willful infringement and validity of claims 3 and 7 of the ’687 patent and claims 1, 9, 11, and 13 of U.S. Patent No. 9,654,367 (the “’367 patent”). The jury awarded Cirba \$84.5 million for the ’687 patent and \$1.5 million for the ’367 patent. (D.I. 1785.)

On October 2, 2023, the PTO issued a Final Office Action again rejecting both asserted claims of the ’687 patent as obvious. A copy of the Final Office Action is attached as Exhibit A.

VMware notes that, at Cirba's request, the Court previously severed and stayed Cirba's claims relating to two of its other patents: U.S. Patent No. 10,523,492 ("492 patent) and U.S. Patent No. 10,951,459 ("459 patent"). (D.I. 1583.) Cirba has appealed from the Final Written Decisions by the Patent Trial and Appeal Board ("PTAB") determining the asserted claims of those two patents to be invalid. Briefing in those appeals remains ongoing.

VMware will keep the Court apprised of any further developments in the reexamination proceedings. Should the Court be interested in its position as to how to proceed in view of the PTO's Final Office Action on the '687 patent, VMware would be happy to provide it. *See CAO Lighting, Inc. v. General Electric Co.*, No. 1:20-cv-681-GBW, D.I. 460, 461 (D. Del. Oct. 2, 2023) (inviting parties' positions on how to proceed in light of IPR decision); *see also CAO Lighting, Inc. v. Osram Sylvania, Inc.*, No. 1:20-cv-690-GBW, D.I. 415 (D. Del. Oct. 2, 2023) (same).

Dated: October 13, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 13, 2023, a copy of the foregoing document was served on the counsel listed below in the manner indicated:

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